

## REMARKS

This paper is filed in response to the Office Action dated November 4, 2003. As this paper is filed on March 2, 2004 and is accompanied by a request for a one-month extension of time, this paper is timely filed.

### I. Status of Amendments

Claims 1-40 were pending prior to this amendment. By this amendment, applicant cancels claims 1-40 without prejudice to refile, and adds new claims 41-92. Thus, claims 41-92 are now pending.

Because applicant previously paid fees for 3 independent and 40 total claims, applicant's amendments requires a further fee of \$198, attached herewith, to be paid for 11 additional dependent claims.

### II. Response to Office Action

#### A. General Comments

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term "invention" may be used to mean various different things.<sup>1</sup> For example, the term "invention" may be used to refer to the technical subject matter that has been invented; the term "invention" may be used to refer to subject matter which is nonobvious; and the term "invention" may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term "invention" in various statements does not mean that the scope of the claims is limited by such statements.

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<sup>1</sup> This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

It should also be understood that, unless a term is expressly defined in the application using the sentence “As used herein, the term ‘\_\_\_\_\_’ is hereby defined to mean...” or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word “means” and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the “broadest reasonable interpretation” of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement.”). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

**B. The November 4 Office Action**

In the November 4 Office Action, claim 15 was objected to as allegedly having an incorrect tense. Moreover, claims 22-24 and 27 were rejected under 35 U.S.C. 112, second paragraph, as allegedly indefinite. Further, claims 1-4, 6-25 and 27-40 were rejected under 35 U.S.C. 103 as allegedly unpatentable over either Turner (U.S. Patent No. 4,684,136) in view of either Walker (U.S. Patent No. 6,193,606) or Vancura (U.S. Publ. No. 2002/0043759) or Turner in view of either Walker or Vancura further in view of Adams (U.S. Patent No. 5,431,408). As claims 1-40 have been cancelled, without prejudice to refile, these rejections are moot. However, given the reliance placed on Turner, Walker and Vancura, applicant has the following comments.

As to claim 41, the claim recites receiving a wager from a player, displaying an image representing a game, and determining if an event has occurred. Claim 41 further recites displaying a matrix including a plurality of spaces if the event has occurred, fewer than all of the plurality of spaces having a trivia topic associated therewith, receiving a selection of a space having a trivia topic associated therewith, selecting a trivia question according to the trivia topic associated with the space selected, displaying the trivia question and a plurality of possible answers to the trivia question, and receiving a selection of one of the plurality of possible answers from the player, determining if the one of the plurality of possible answers is correct, and providing an award if the one of the plurality of possible answers is correct.

Assuming, *arguendo*, that Turner is combinable with Walker or Vancura (a point which applicant does not concede), the combination of these references does not teach each and every limitation of claim 41. In particular, Turner, Walker, and/or Vancura, whether taken individually or in combination, do not disclose, teach or suggest displaying a matrix including a plurality of spaces if the event has occurred, fewer than all of the plurality of spaces having a trivia topic associated therewith. As admitted, neither Walker nor Vancura disclose any matrix at all, and these references are cited only in combination with Turner for its allegedly corresponding matrix. However, it is stated in Turner that "each tic-tac-toe arrangement 22 is labeled as a different subject area, such as Math, History, Science . . . or the like." Col. 1:67-2:3. Moreover, Turner further states "Each playing piece 16 is placed into an aperture 18 on the playing board 12 until three tic-tac-toe arrangements 22 are won in a vertical, horizontal or diagonal row to completely win the game." Col. 2:13-17. Consequently, following Turner's statements, wherein all possible options for winning the game are to be permitted, one skilled in the art would not understand Turner to teach or suggest use of a matrix wherein less than all of the spaces are associated with trivia topics.

Therefore, whether taken individually or in combination, Turner, Vancura and Walker do not disclose, teach or suggest the claimed subject matter of claim 41. Given that claims 42-58 depend from claim 41 and that claim 41 is distinguishable from Turner, Vancura and Walker, so too are claims 42-58.

As to claim 59, the claim recites a gaming system having a display device, a wager input device and a processing unit. The processing unit is coupled to the display device and the wager input device, receiving a wager from a player, causing the display unit to display an image representing a game, determining if an event has occurred, causing the display unit to display a matrix including a plurality of spaces if the event has occurred, fewer than all of the plurality of spaces having a trivia topic associated therewith, the at least one processing

unit receiving a selection of a space having a trivia topic associated therewith, the at least one processing unit selecting a trivia question according to the trivia topic associated with the space selected, the at least one processing unit causing the display unit to display the trivia question and a plurality of possible answers to the trivia question, the at least one processing unit receiving a selection of one of the plurality of possible answers from the player, the at least one processing unit determining if the one of the plurality of possible answers is correct, and the at least one processing unit providing an award if the one of the plurality of possible answers is correct.

As above, one skilled in the art would not understand Turner to teach or suggest the use of a matrix wherein less than all of the spaces are associated with trivia topics and that neither Walker nor Vancura disclose a matrix at all. Therefore, whether taken individually or in combination, Turner, Vancura and Walker do not disclose, teach or suggest the claimed subject matter of claim 59. Given that claims 59-76 depend from claim 59 and that claim 59 is distinguishable from Turner, Vancura and Walker, so too are claims 59-76.

As to claim 77, the claim is similar to claims 5 and 26, previously found to be allowable. In particular, claim 77 recites a gaming method that includes determining if a player chooses to enter a bonus game if the event has occurred, and displaying a matrix including a plurality of spaces if the player chooses to enter a bonus game, one or more of the plurality of spaces each having a trivia topic associated therewith. Therefore, in keeping with the statements made in paragraph 11 of the November 4 Office Action, this claim as well as claims 78-92 that depend from claim 77 should be allowable.

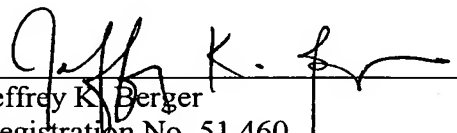
Therefore, in view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below. Further, if there are any additional fees or refunds required, the Commissioner is directed to charge or debit Deposit Account No. 13-2855.

Respectfully submitted for,

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